

Appl. No. : 09/879,981
Amdt. dated : June 1, 2004
Reply to Office Action dated March 30, 2004

REMARKS

Claims 2 through 14 and 22 through 28 are pending. Claims 15 through 21 have been canceled without prejudice or disclaimer of the subject matter contained therein. New claims 23 through 28 have been added. Claims 2, 7 and 23 are the independent claims.

The Examiner has required restriction to one of two inventions under 35 U.S.C. §121.

The Examiner has objected to the numbering of the claims.

Claims 2 through 6 and 22 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claims 2 through 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weil et al (US 2003/0093409) in view of Foulger et al (U.S. Patent No. 6,578,022).

New Claims

New claims 23 through 28 have been added and contain similar recitations to claims 2 through 14 and 22.

Election / Restriction

The Examiner has issued a restriction requirement that requires election of one of two groups of claims for examination. Specifically, Group I, claims 2 through 14, and Group II, claims 15 through 21. Applicants' representative informally elected Group I with traverse in a telephone interview with the Examiner on March 19, 2004. Applicants formally elect Group I without traverse.

Claim Objections

The Examiner has objected to the claims for not being in accordance with 37 CFR §1.126. Applicants have renumbered the second instance of claim "2" as claim --22--. Therefore, Applicants believe the objection to be moot and respectfully request the Examiner withdraw the objection.

Appl. No. : 09/879,981
Amdt. dated : June 1, 2004
Reply to Office Action dated March 30, 2004

35 U.S.C. § 101 Rejection

Claims 2 through 6 and 22 were rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Claim 2 has been amended to include similar claim recitations as found in claim 7 to overcome the rejection. Specifically, claim 2 now recites, *inter alia*:

A method for providing a user-specific response, the method comprising:
receiving an inquiry from a user;
associating the user with a search profile designated by a subscriber on a network;
conducting a search delimited by the search profile in a database on the network;

Since, claim 2 now contains similar recitations as in claim 7, specifically, “conducting a search delimited by the search profile in a database on the network,” (emphasis added), the Section 101 rejection is believed to be moot. Therefore, the Examiner is respectfully requested to withdraw the Section 101 rejection of claims 2 through 6 and 22.

35 U.S.C. § 103(a) Rejection

Claims 2 through 14 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Weil et al (US 2003/0093409) in view of Foulger et al (U.S. Patent No. 6,578,022).

Regarding claims 2 and 7 through 11, the Examiner asserts that:

“Weil discloses a method, system and network for providing a user-specific response, the system comprising (fig. 1, items 104, 120 and 130 Weil);
receiving an inquiry from a user; (fig. 2, items 136 and 210, Weil)
associating the user with a search profile designated by a subscriber; (fig. 2, 214, Weil)
conducting a search delimited by the search profile; (fig. 2, 220, Weil)
providing a search result to the user; (fig. 2, 240, Weil)
reporting the search result to the subscriber; (fig. 2, 250, Weil) and,
receiving a request for additional information from the user; (page 4, par. 27, lines 1-5, Weil), but Weil does not teach an expert system.

However, Foulger teaches an interactive intelligent searching system (title, Foulger) wherein an expert is in contact with a user in response to a user's request (fig. 1, items 110, 125 and 135, Foulger). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used an expert in Weil as used in Foulger by interconnecting the expert to the internet network of Weil (fig. 1, 120, Weil). One would have been motivated to use an expert in the Weil system to provide answers to customer requests not contained in the content files and databases.”

Appl. No. : 09/879,981
Amdt. dated : June 1, 2004
Reply to Office Action dated March 30, 2004

Claim 2 recites, *inter alia*:

“receiving a request for additional information from the user;
initiating a contact between the user and an expert in response to the request for additional information; and
receiving the expert’s response and forwarding the response to the user.”

Contrary to the Examiner’s assertion, there is nothing in the Weil et al. publication that discloses or suggests, receiving a request for additional information from the user, “initiating a contact between the user and an expert in response to the request for additional information; and receiving the expert’s response and forwarding the response to the user,” as recited in claim 2. Specifically, the portion of the Weil et al. publication relied on by the Examiner for the “receiving a request for additional information from the user” (page 4, par. 27, lines 1-5 Weil) rejection is merely the specification section that describes “(fig. 2, items 136 and 210, Weil)” that the Examiner used to reject “receiving an inquiry from a user.” (See Office Action, page 5, first paragraph.) Therefore, this is not the second “request for additional information from the user and, thus, the Examiner has failed to meet the required burden of establishing a *prima facie* case of obviousness of claim 2. Accordingly, claim 2 and claims 3 through 6 and 22 that depend therefrom are believed to be allowable and the Examiner is respectfully requested to withdraw the Section 103 rejection and issue a notice of allowance.

Claim 7 recites, *inter alia*:

“forward the inquiry to a consultant in response to a request for further information by the user.” (Emphasis added.)

Similar to claim 2, there is nothing in the Weil et al. publication or the other cited patents that discloses or suggests, at a minimum, to “forward the inquiry to a consultant in response to a request for further information by the user,” as recited in claim 7. Therefore, for at least those reasons given above for claim 2, the Examiner has failed to meet the required burden of establishing a *prima facie* case of obviousness of claim 7. Accordingly, claim 7 and claims 8 through 14 that depend therefrom are also believed to be allowable.

Appl. No. : 09/879,981
Amdt. dated : June 1, 2004
Reply to Office Action dated March 30, 2004

CONCLUSION

In view of the above remarks, the Applicants respectfully submit that no new matter has been added and that the present case is in condition for allowance or, at least, in better form for appeal.

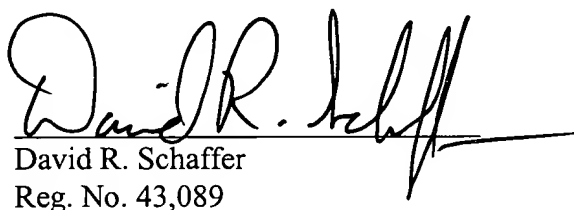
Therefore, the Examiner is respectfully requested to enter the instant amendment and issue a notice of allowance for claims 2 through 14 and 22 through 28.

Although, no fee is believed to be due, the Commissioner is authorized to charge any fees determined to be necessary under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayment to Kenyon & Kenyon **Deposit Account No. 11-0600**.

The Examiner is invited to contact the undersigned at (202) 220-4263 to discuss any matter concerning this application.

Respectfully submitted,

KENYON & KENYON


David R. Schaffer
Reg. No. 43,089

Dated: June 1, 2004

1500 K Street, N.W.
Suite 700
Washington, D.C. 20005
Tel: (202) 220-4200
Fax: (202) 220-4201

DC01 493326_1.DOC